

The opinion in support of the decision being entered today is not binding precedent of the Board.

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Filed
3 July 2003

Paper 92

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FAXED

RANDOLPH NOELLE

Junior Party,
(Application 08/742,480),

v.

RICHARD J. ARMITAGE,
WILLIAM C. FANSLow, and MELANIE K. SPRIGGS

Senior Party,
(Application 09/322,021).

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

JUL 3 - 2003

Patent Interference No. 104,724

Before: TORCZON, LANE, and NAGUMO, Administrative Patent Judges.
NAGUMO, Administrative Patent Judge.

DECISION ON NOELLE REQUEST FOR RECONSIDERATION

I.

Noelle has requested reconsideration of our decision (Paper 89) granting Armitage's Preliminary Motion 1, in part, and issuing final judgment. Noelle argues that the decision:

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1. Ruled for the first time that the Board had discretion to decline to order a priority phase. (Paper 91 at 2 and 8.)
2. Established a three-part test to decide whether or not to exercise that discretion. (Paper 91 at 2.)
3. Erred in deciding, under part two of the test, that Noelle had not made an effort to preserve a claim to patentable subject matter. More specifically, Noelle urges that the Board overlooked Noelle's claim 45, designated as not corresponding to the count, which in fact corresponds to the count. (Paper 91 at 9-10.)
4. Erred in concluding, under part 3 of the test, that Noelle was unlikely to succeed in proving priority of invention based on its preliminary statement. (Paper 91 at 11-12.)

We have reconsidered our decision, but will not grant relief.

II.

A.

Our earlier decision considered the proper course of action in this case when it had been determined that the junior party, Noelle, was not entitled to a patent containing any claim designated as corresponding to the count, and that there had been no more than a mere pleading regarding priority in the

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interference. In this case, in contrast to many cases in the past, at the time of the decision on the preliminary motions, there had been no substantive testimony, cross examination evidence, or argument regarding priority. We expressly declined to use this case as a vehicle to pronounce broad interpretations of the law or of our procedures. (Paper 89 at 7, first full paragraph.) The decision to proceed necessarily depends on the facts in each case regarding the status and relative positions of the parties, and their actions, including whether the interference was provoked (not a factor on the facts before us), and the extent to which the parties may have been constrained from taking certain actions by the proceedings. (Paper 89 at 13.)

In this particular case, we found three relevant factors. First, both parties are applicants, and neither copied the claims of the other. The senior party is presumed to have been the first to invent 37 CFR § 1.657(a); Noelle, as the junior party, bears the burden of proving it was the first to invent. (Paper 89 at 16-17.) Second, Noelle made no efforts, beyond opposing Armitage's preliminary motion on the merits, to preserve or present patentable claims corresponding to the count. For example, Noelle did not seek to add, under 37 CFR § 1.633(d), claims that were supported by its application and that interfered with Armitage's claims. (Paper 89 at 17.) Nor did Noelle seek

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to redefine the interfering subject matter by designating an application claim to correspond to the count, under 37 CFR § 1.633(c). (Paper 89 at 17.) Third, we found that Noelle's preliminary statement, while sufficient for "notice pleading," offered too scant and debatable a basis to decide that refraining from deciding priority would result in the issuance of a facially invalid patent.

B.

Noelle does not renew its argument that the Board acted contrary to statute and judicial precedent when it determined not to order a priority phase. (Paper 91 at 8-9.) Nor does Noelle argue that the "test" fails to perform its intended function. Rather, Noelle argues only that the Board erred in its evaluation of the second and third factors of its "test." (Paper 91 at 9-12.)

Regarding the second factor, that Noelle made no efforts to preserve or present a patentable claim in response to Armitage's motion for unpatentability, Noelle urges that we overlooked the presence of its claim 45. Noelle argues that claim 45 in fact corresponds to the count, in that it is a species within the scope of Noelle's claim 42, which defines, in part, the count. (Paper 91 at 9-10.) Noelle argues further that Armitage's failure to move to designate claim 45 as corresponding to the count is a concession of the patentability of the subject matter

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of claim 45, and a concession that Noelle has priority to that invention. (Paper 91 at 10.) Noelle asserts that it has "consistently and diligently pursued claims directed to subject matter which corresponds to the count," and that it should be entitled to prove a date of invention for the subject matter of claim 45. (*Id.*) Noelle concludes that factor 2 weighs in its favor for presenting a case for priority.¹ (*Id.*)

Regarding the third factor, Noelle urges that the Board improperly treated its preliminary statement as evidence, rather than as a pleading. (Paper 91 at 11.) Moreover, Noelle urges that, having denied Noelle the opportunity to present evidence explaining its showing, the Board was not in a position to appreciate the import of the page of Noelle's research records submitted with its preliminary statement. (Paper 91 at 11-12.) Noelle concludes that the Board misused its preliminary statement, which exists for procedural, rather than evidentiary purposes. (Paper 91 at 12.)

¹ In its summary, Noelle also argues that, while it could have moved to designate claim 45 as corresponding to the count, "the principal onus and motivation for doing so was on Armitage, not Noelle." (Paper 91 at 2.) Noelle argues further that requiring Noelle to bring claim 45 into the interference would require that Noelle be prescient that the Board would grant Armitage's Preliminary Motion 1 for lack of enablement; that the Board would not order a case on priority; and that Noelle's failure to bring the claim in would be adopted as a factor in its decision not to order a priority case. (Paper 91 at 2-3.)

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III.

A.

Noelle's argument regarding "the second factor" is not persuasive. First, neither party raised the status of claim 45, which was designated as not corresponding to the count in the declaration of this interference. (Paper 1 at 5.) We cannot have misapprehended or overlooked a point that neither party argued.

On the merits, it is insufficient to argue, as Noelle has done, that the subject matter of claim 45 is fully encompassed by the count, or, equivalently, that the genus covered by claim 42 includes the species covered by claim 45. Ultimately, a claim corresponds to a count if the claimed subject matter is the same patentable invention as subject matter claimed by the other party that corresponds to the count. 37 CFR § 1.637(c)(3)(ii). It was Noelle's burden, in a timely motion, to demonstrate that the species covered by claim 45 was not patentable over one of Armitage's claims that correspond to the count. Having failed to make such a showing, Noelle's argument must fail.

Noelle's argument is also untimely. Noelle had two opportunities to make its argument regarding claim 45: during TIME PERIOD 1, or during TIME PERIOD 2. Its argument now is belated and unexcused by any argument showing good cause why it

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was not timely presented. Cf. 37 CFR § 1.645(b)². Moreover, not having raised the status of claim 45 in a preliminary motion, Noelle would be barred from raising the issue at final hearing. 37 CFR § 1.655(b)³. Whether Noelle did not notice that claim 45, in its opinion, should correspond to the count, or whether it decided, for its own good reasons, not to contest its designation as not corresponding to the count, it may not, at this late date, relitigate the issue.

Noelle's effort to shift to Armitage the onus of moving to designate claim 45 as corresponding to the count is without merit. Armitage must henceforth labor under the consequences of its 'failure' to move that Noelle's claim 45 be designated as corresponding to the count. 37 CFR § 1.658(c). Armitage has effectively conceded that it has no claim in this interference that could bar a patent containing claim 45 to Noelle. These considerations, however, do not excuse Noelle's 'failure' to take an action it could have taken in this interference.

² ("Any paper belatedly filed will not be considered except upon motion [sic: motion] (§ 1.635) which shows good cause why the paper was not timely filed")

³ ("A party shall not be entitled to raise for consideration at final hearing any matter which properly could have been raised by a motion under § 1.633 or 1.634 unless the matter was properly raised in a motion that was timely filed by the party under § 1.633 or 1.634 and the motion was denied or deferred to final hearing").

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B.


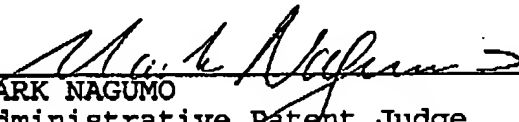
Noelle's complaint that the Board considered, improperly and inadequately, the merits of its preliminary statement, and used it as an evidentiary, rather than as a purely procedural, matter is also not persuasive. Noelle has misapprehended the point of our discussion of the third factor, which was that if the record thus far developed contained a compelling reason to doubt Armitage's priority, we might have exercised our discretion differently. Noelle is half right in stating that 37 C.F.R. § 1.629(e) bars the use of its preliminary statement as evidence. Rule 629(e) bars the use of a preliminary statement as evidence on behalf of the filer. Consequently, we cannot use Noelle's pleading as evidence against Armitage. In sum, we lack a junior party with interfering claims and evidence of record that Armitage is not senior to Noelle. Finally, Noelle's reliance on 37 C.F.R. § 1.629(d) as a basis for error is curious because the panel looked to Noelle's preliminary statement to see if the attachments provided compelling evidence that Armitage was not senior. To the extent we erred, it was in an effort to reach priority as Noelle wishes. The lack of evidence was but one of several factors in this case that, in total, weighed in favor of awarding judgment against Noelle in this case.

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IV

Noelle's request for reconsideration is denied.


SALLY GARDNER LANE)
Administrative Patent Judge)

MARK NAGUMO)
Administrative Patent Judge)

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TORCZON, Administrative Patent Judge, concurring.

While I agree with the principal opinion, I write separately to address two confusing aspects of the request for reconsideration.

Noelle explains that its request for reconsideration was necessitated by the Board's "articulation of a new and different rationale [than that propounded by Armitage] for reversing its prior decision to allow a priority determination in this case." (Paper 91 at 1.) The request, according to Noelle, is its first opportunity to respond to the rationale and its factual underpinnings.

Noelle's argument that the Board overlooked claim 45 in determining that Noelle had made no effort to preserve a claim to patentable subject matter corresponding to the count is troubling in two regards. First, it incorrectly states the basis for correspondence. Second, it improperly attempts to shift the burden (and the blame) to Armitage and the Board to have claim 45 designated as corresponding.

Correspondence is an accounting mechanism for determining what claims would be lost to the party that loses the count. As such, correspondence is a provisional rejection of designated claims as anticipated by or obvious in view of a claim indisputably corresponding to the count. Cf. *In re Deckler*, 977 F.2d 1449, 1451, 24 USPQ2d 1448, 1450 (Fed. Cir. 1992) (the

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losing party in an interference is not entitled to a patent covering claims patentably indistinguishable from the lost count); 37 C.F.R. § 1.637(c)(3). Noelle's statement that claim 45 is within the scope of corresponding claim 42 is meaningless in this context. It is well-settled that a claimed species within a genus is patentably distinct from the genus absent some basis for supposing otherwise. *E.g.*, *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As the record stands, no one has provided a reason to believe that claim 45 would be properly provisionally rejected over the subject matter of claim 42 or any other claim corresponding to the count.

The burden shift is all the more troubling in light of the nature of correspondence as a provisional rejection. Noelle contends that it has reason to believe that claim 45 should correspond—that is to say, should be provisionally rejected—along with claim 42, but that it is under no obligation to assist the Board in making that rejection. This contention is fundamentally at odds with a system that relies on the candor of those seeking patents.


RICHARD TORCZON
Administrative Patent Judge

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